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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/408,447	09/29/1999	TSUKASA SAKO	862.3050	4061

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EXAMINER

KIM, CHONG R

ART UNIT	PAPER NUMBER
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2623

DATE MAILED: 10/08/2003

11

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/408,447

Applicant(s)

SAKO ET AL.

Examiner

Charles Kim

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on July 24, 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 40-111 is/are pending in the application.
- 4a) Of the above claim(s) 40-75,80-93,98-105,107,108,110 and 111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 76-79,94-97,106 and 109 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 September 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

1. The amendment filed July 24, 2003 has been entered and made of record.
2. In view of applicant's amendment and further consideration by the Examiner, the Restriction dated April 22, 2003 has been withdrawn.

Election/Restrictions

3. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species A, claims 68-75, 80-93, 98-105, 107-108, 110-111 as shown in figure 20

Species B, claims 76-79, 94-97, 106, 109 as shown in figure 5

Election by Original Presentation

4. Newly submitted claims 68-75, 80-93, 98-105, 107-108, 110-111 (Species A) are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The new claims 68-75, 80-93, 98-105, 107-108, 110-111 (Species A) are drawn to a species of the invention which are distinct from the specie of the invention previously claimed in claims 1-38. Claims 68-75, 80-93, 98-105, 107-108, 110-111 are drawn to a specie which corresponds to the fourth embodiment, described on pages 21-29 of the specification, and shown in figure 20. Claims 76-79, 94-97, 106, 109 (Species B) are drawn to a specie which

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corresponds to the first embodiment, described on pages 9-17, and shown in figure 5. Previous pending claims 1-38 were also drawn to a specie which corresponds to the first embodiment, described on pages 9-17, and shown in figure 5. The Examiner notes that the new claims 76-79, 94-97, 106, 109 (Species B) are drawn to the same specie as the originally claimed invention (previously pending claims 1-38).

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 68-75, 80-93, 98-105, 107-108, 110-111 (Species A) are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Since claims 1-38 were canceled by the amendment filed on February 10, 2003, current pending claims 76-79, 94-97, 106, 109 (Species B) have been constructively elected by original presentation for prosecution on the merits.

Claim Objections

5. Claims 76-79 are objected to because of typographical errors. It appears that the applicant intended the phrase "plurality of output media sizes" to read "'plurality of output medium sizes". A similar rejection is also applicable to claim 78, in line 7. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 76-77, 94-95, 106, 109 are rejected under 35 U.S.C. 102(e) as being anticipated by Endo et al., U.S. Patent No. 6,335,796 (“Endo”).

Referring to claim 76, Endo discloses an image processing system for processing image data obtained by computerizing an input image and outputting the image data to an output medium, the apparatus comprising:

- a. designation means for designating an observation area in the image data (col. 5, lines 35-37)
- b. selection means for selecting one of a plurality of output medium sizes (col. 5, lines 37-39)
- c. changing means for changing output method based on a relationship between the designated observation area and the output medium size selected by the selection means (col. 6, lines 42-47).

Referring to claim 77, Endo further discloses that the changing means changes an output method based on whether or not the observation area falls within an effective image area of the selected output medium size (col. 6, lines 42-47).

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Referring to claims 94, 106, 109, see the rejection of at least claim 76 above.

Referring to claim 95, see the rejection of at least claim 77 above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 78-79, 96-97 are rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Endo et al., U.S. Patent No. 6,335,796 ("Endo") and Tabata et al., U.S. Patent No. 5,774,232 ("Tabata").

Referring to claim 78, Endo further discloses that the changing means includes a life-size output method wherein an observation area is outputted in an actual size (col. 10, lines 63-65), a reduction image output method where an observation area is reduced and then outputted (col. 11, lines 8-10), and an extraction output method where a predetermined area is extracted from the observation area and then outputted (col. 11, lines 2-8. Note that the "area of concern" in line 7 extracts a predetermined area such as the lung area to be output.).

Endo fails to teach a segmenting output method where an observation area is segmented into a plurality of segmentation areas and outputted to a plurality of output medium. However, this feature was exceedingly well known in the art.

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For example, Tabata teaches a segmenting output method where an observation area is segmented into a plurality of segmentation areas and outputted to a plurality of output medium (col. 16, line 66-col. 17, line 9 and figure 7).

Therefore, since Endo and Tabata are both concerned with outputting an image on different output medium sizes, it would have been obvious to modify the changing means of Endo, so that it includes a segmenting output method in which the observation area is segmented into a plurality of segmentation areas and outputted to a plurality of output medium, as taught by Tabata, in order to obtain an output of the complete observation area, thereby eliminating any loss of image data.

Referring to claim 79, Endo further discloses that the changing means changes the output method from the life-size output method to one of the reduced image output method, when the selection means can not select an appropriate output medium (col. 11, lines 20-33).

Referring to claim 96, see the rejection of at least claim 78 above.

Referring to claim 97, see the rejection of at least claim 79 above.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charles Kim whose telephone number is 703-306-4038. The examiner can normally be reached on Monday thru Thursday 8:30am to 6:00pm and alternating Fridays 9:30am to 6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amelia Au can be reached on 703-308-6604. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-306-0377.

ck

October 2, 2003


AMELIA M. AU
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600